UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/400,649
Filing Date: September 21, 1999
Appellant(s): SZABO, ANDREW J.

Steven M. Hoffberg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 8, 2004 appealing from the Final

Office action mailed January 7, 2004.

(1) Real Party in Interest

The Brief identifies "Alberti Anenometer, LLC" as the real party of interest. In appellant's paper of November 9, 2005, appellant clarified the real party of interest as "Smeaton Pump, LLC", which matches the current assignment record. MPEP 1205.02 permits appellant to submit the clarification of November 9, 2005, and since the clarification matches the assignment of record, it is accepted. "Smeaton Pump, LLC" is accepted as the real party of interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection filed on May 6, 2004 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. Patent 5,845,255 to Mayaud. Published December 1, 1998. Filed October 2, 1997.

Continuation of Application 08/330,745, filed October 28, 1994.

(9) Grounds of Rejection

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 60 and 67-73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 60: The original disclosure does not state that the "likelihood of adoption" is part of the optimization process, or is a variable in the optimization process. This amended phrase is thus new matter.

Claim 67: The original disclosure does not state that the "likelihood of adoption" is a variable in a joint analysis. This amended phrase is thus new matter.

Claims 68-73: Claims 68-73 depend from claim 67.

Claims 51, 60 and 67-73 are considered to contain new matter and will not be further examined on the merits.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29-33, 35-50, 52-59, 61-66 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Mayaud (U.S. Patent 5,845,255).

Claim 29: FIG. 7 of Mayaud discloses a user interface which receives input from a user in the form of a medical condition to evaluate records (medications) for prescription to a patient. In the case of FIG. 7, the user input is the condition "PUD/Gastritis".

A subset of records (suggested medications in FIG. 7) are then automatically created based upon the classification of information (formulary/non-formulary drugs) and the user input ("PUD/Gastritis").

As described at col. 39, lines 55-67, the initially selected drug can be evaluated in accordance with the patient's history record. That record includes a listing of drug allergies (col. 19, lines 28-30). Drug allergies are a statistical risk associate with a record of a drug in a database.

As described at col. 39, lines 43-54, the system allows determination of economic parameters (cost of drug) and allows the physician to select or block drugs based on cost.

The resulting output is shown in FIG. 11, and will include a drug or drugs that have been automatically (by computer) optimized for both the risk to the patient and the economic cost. This is considered to be an automatic optimization since it is performed by the assistance of a computer program, and a joint optimization since it considers two separate variables (cost and allergic risk)

Claim 30: The user input ("PUD/Gastritis") is health information.

Claim 31: Col. 19, lines 28-30 call for the input of patient allergies, which reads as an input of data pertaining to risk tolerance.

Claim 32: FIG. 7 is a user interface.

Claim 33: The economic parameters which are considered (col. 39, lines 44-54) pertain to cost.

Claim 35: The user input ("PUD/Gastritis") is a semantic expression.

Claim 36: In FIG. 7, the user can input a preference, such as a preference for formulary or non-formulary medications.

Claim 37: The user feedback is a selection of a drug for a patient. If the user receives warnings about that drug (col. 40, lines 1-19), the drug selection can be cancelled and another drug selection made.

Claim 38: Col. 39, lines 44-54 outline a plurality of different optimization procedures which can be followed.

Claim 39: Col. 9, lines 44-45 call for the creation of an electronic prescription which is transmitted electronically to a pharmacy. This inherently leads to the transaction of a sale of a medication at a pharmacy.

Claim 40: The transmission of the electronic prescription is a transmission between a server (206) and a client computer at a pharmacy.

Claim 41: The system of Mayaud utilizes the Internet (col. 48, line 2).

Claim 42: The system of Mayaud is implemented by a network of a computer systems each containing programmed instructions for controlling the respective computers.

Claim 43: FIG. 7 is a graphic user interface.

Claim 44: See claim 29. The user relevance parameter is the input of ("PUD/Gastritis") by the user in FIG. 7.

Claim 45: See remarks for claim 30.

Claim 46: The facility (206) functions as a search engine for searching databases (210, 212).

Claim 47: See remarks for claim 41.

Claim 48: See remarks for claim 33.

Claim 49: Col. 40, lines 1-10 discuss the presentation of drugs, as well as choices of alternative drugs that can be presented to the user. These choices are presented based upon the user input of risks (allergies/interactions) and economic parameters (cost).

Claim 50: The input of a disease by a user, such as "PUD/Gastritis" pertains a population grouping, since a population of patients can have this disease.

Claim 52: See remarks for claim 37.

Claim 53: See remarks for claim 38.

Claim 54: See remarks for claim 39.

Claim 55: See remarks for claim 40.

Claim 56: See remarks for claim 41.

Claim 57: See remarks for claim 42.

Claim 58: See remarks for claim 43.

Claim 59: See remarks for claim 29. The "specification" is the indication of disease "PUD/Gastritis" by the user in FIG. 7.

Claim 61: See remarks for claim 38.

Claim 62: Col. 19, line 30 calls for the input of a relevance profile (allergic reaction information).

Claim 63: See remarks for claim 39.

Claim 64: See remarks for claim 41.

Claim 65: See remarks for claim 42.

Claim 66: See remarks for claim 43.

Claim 74: Col. 39, line 50 illustrates that the economic parameters are dictated by an external third party (benefit management company).

(10) Response to Argument

Preliminary Note: Appellant presents a grouping of the claims as the basis for separate consideration of individual claims. The grouping is presented on pages 6-11 of appellant's brief. The arguments in the brief are not in the order of the grouping presented. Accordingly, when discussing each grouping as follows, the location of the arguments in the brief will be indicated.

Claims 29, 32 and 42: For claim 29, arguments are presented on page 18 of the brief. Appellant also cites from sections of Mayaud on pages 18-20 of the brief. However, none of the sections relied upon by appellant were cited by the examiner, and appellant makes no attempt to address any of the figures or sections which were actually cited by the examiner as the basis for the final rejection. In just the discussion of claim 29 alone, examiner provided five different citations from Mayaud (two figures and three section quotes) to support the rejection, to which appellant has not discussed or considered a single one.

Examiner maintains that Mayaud teaches the joint optimization of economic and risk
factors, and taught by Mayaud in col. 39, lines 43-67, FIGS. 7 and 11 and supported by the
explanation associated with claim 29. Appellant has not addressed any of these citations.

Mayaud is generally directed to the concept of providing an optimal choice of medication
as a recommendation to a physician based on inputs of several different types of information
derived from a patient. Arguing that the prescription system of Mayaud does not provide an
optimal choice or optimized choice logically leads to the conclusion that the system of Mayaud
is designed to present inferior or non-optimized choices. Such a line of reasoning clearly runs
contrary to the teachings of Mayaud (col. 4, lines 20-34).

Claims 44, 46 and 57: Appellant's arguments for claim 44 are presented on pages 18-20
of the brief and are the same arguments as those presented for claim 29. Appellant presents
additional discussion for claim 44 at page 21, second paragraph of the brief, but the discussion
contains no mention of the prior art reference. Here, appellant asserts that the claim requires a
"user relevance parameter", but makes no assertion that such feature is lacking in Mayaud. As
discussed in the detailed rejection, the relevance parameter is the input of "PUD/Gastritis" in Fig.
7. No argument to the contrary is presented. No specific arguments are presented for claims 46
and 57.

Claims 59, 64 and 65: Appellant's arguments for claim 59 are presented on pages 18-20
of the brief and are the same as those presented for claim 29. Appellant presents additional
discussion for claim 59 at page 21, third paragraph, pointing out that claim 29 calls for a
statistical risk associated with records within a class of information and a received specification.
In the rejection above, the statistical risk is the risk of a drug allergy as recited at col. 19, lines

28-30. Such information is within a class of information (patient information generally or the

patient record specifically). The received specification is any information input by the user.

Appellant presents no assertion that these claimed features are lacking in Mayaud. No arguments

are presented for claim 65. Arguments are presented for claim 64, but are discussed separately

below.

Claim 67: Claim 67 was rejected under 35 USC 112, first paragraph for have been

amended to recite new matter. No prior art rejection has been applied. Appellant's arguments are

presented at page 15, second paragraph through page 16 of the brief. The particular phrase found

to be new matter is the phrase "likelihood of user adoption", and is used to refer to a likelihood

of a user adopting a particular selection. Appellant presents six different quotations from the

original specification that allegedly demonstrate this feature. However, none of the quotations

use the phrase "likelihood of user adoption" nor would the skilled artisan at the time of invention

interpret such feature to present within the given quotations. The primary problem is that these

quotations do not discuss what is meant by "adoption" nor do they discuss what is meant by a

"likelihood". At best, the quotations only refer to the construction of a proposal to a user, not an

analysis of the chances that a user will actually adopt the proposal that is constructed.

Accordingly, the feature "likelihood of user adoption" is found to be lacking in the original

specification, and the rejection under 35 USC 12, first paragraph is maintained.

Claims 30 and 45: Argument is presented at the last paragraph of page 22 in the brief.

Appellant argues that there is no teaching of records retrieved in a content sensitive manner and

further that patient privacy concerns would weigh against performing such a search. Such

arguments are moot, as claims 30 and 45 contain no such requirements. Claims 30 and 45 are

addressed to the input of health information and appellant admits the anticipation of this feature

in the second line of the discussion.

Claim 31: Argument is presented on page 23 of the brief. Appellant argues that Mayaud

does not teach an input corresponding to a risk tolerance. This argument is not correct. In

Mayaud, the input of risk tolerance corresponds to an input by the user (through a selection) of

allergy information (col. 19, lines 28-30). This corresponds to the input of data corresponding to

risk tolerance. An allergy is a risk factor in drug prescriptions, and the selecting of allergy

information is the input of information pertaining to such allergy, as well as indicating

intolerance towards the allergen. It is not an output of information at this point in the Mayaud

reference, as appellant argues.

Claims 33, 48 and 69: Argument is presented on page 23 of the brief. Appellant argues

that Mayaud does not perform an optimization process based on a joint analysis of two

parameters. This argument is not correct. Col. 39, lines 43-54 and col. 39, lines 55-67 of Mayaud

establish that the drug selection is optimized by the consideration of two variables, namely, risk

of allergic reaction and cost to the patient. It is observed that appellant makes no rebuttal or

discussion of the quotations from Mayaud cited by the examiner. No additional arguments are

presented for claims 48 and 69.

Claims 35 and 68: Argument is presented on page 23 of the brief. Appellant arguments

are ambiguous here, but appear to be suggesting that the term "semantic" implies "non-

parametric". This argument is not correct. The word "semantic" was not defined in appellant's

original specification, so it does not necessarily imply "non-parametric". Considering the

definition of the phrase "semantic expression" as used in claim 35 and in defined in the Merriam

Webster Dictionary (on-line version), the phrase implies an expression having a particular

meaning. In Mayaud, the phrase "PUD/Gastritis" is an expression that has a particular meaning

in medicine, namely, "peptic ulcer disease (PUD)" and "gastric inflammation (gastritis)". No

arguments are presented for claim 68.

<u>Claim 36:</u> Argument is presented at page 23 of the brief. Appellant argues that Mayaud

does not disclose "re-optimizing based on a user feedback input". This argument is moot, as

claim 36 makes no mention of any "re-optimization" process.

<u>Claims 37 and 52:</u> Appellant's argument is presented at page 24 of the brief. Appellant

argues that Mayaud does not disclose a re-optimization process. Appellant does not consider any

of the portions of Mayaud cited by the examiner, and thus appellant's arguments are moot.

<u>Claims 38, 53 and 61:</u> Appellant's arguments are presented at page 24 of the brief.

Appellant argues that Mayaud does not disclose an optimization process. This argument is not

correct. The output screen in FIG. 11 presents an output of single recommended drug, which is

the optimal choice based on all the input information.

<u>Claims 39, 54 and 63:</u> Appellant's arguments are presented at page 24 of the brief.

Appellant argues that a transaction occurs with a user, and that a patient is not a user. This

argument is moot, as examiner is not making such a correlation. Claim 39 calls for a transaction

to occur involving a sale, with a "the person". The "person" is not the same as the "the user"

recited in claim 29, so the sale can essentially occur with any party. In Mayaud, the sale occurs

between a pharmacy and a customer. Accordingly, the "person" could either be the pharmacist or

a customer in the pharmacy purchasing the subscription. No arguments are presented for claims

54 and 63.

Claims 40 and 55: Appellant's arguments are presented at page 24 of the brief. Appellant's argument is a blanket assertion that Mayaud does not teach electronic communication. Appellant's argument does not consider the citation from Mayaud provided by the Examiner which describes a server handling electronic communication.

Claims 41 and 56: Appellant's arguments are presented at page 24 of the brief. Appellant argues that Mayaud does not disclose transactions over the Internet. Appellant does not consider Examiner's citation from Mayaud at col. 48, line 2 teaching communication over the Internet.

Claims 43, 58 and 66: Appellant's arguments are presented at page 25 of the brief. Appellant argues that "the prior art in general" does not teach the presentation of data through a graphical user interface (GUI). Once again, appellant disregards the citations cited by the Examiner in Mayaud, and does not even consider Mayaud as the prior art in this instance. In particular, appellant does not address the teaching of a graphical user interface in FIG. 7 of Mayaud.

Claim 47: Appellant's arguments are presented at page 25 of the brief. Appellant does not address or consider the citation from Mayaud (col. 48, line 2) which addresses this claim.

Claim 49: Appellant's arguments are presented at page 25 of the brief. Appellant argues that Mayaud does not teach the output of a sorted list that is based upon the input parameters. Col. 40, lines 1-10 are discussed by appellant, but appellant asserts that the features described in the citation do not pertain to a sorted list. This argument has been considered, but is not correct. Col. 40, lines 1-10 refer to the features of FIG. 11. This figure illustrated a list of drugs that have been sorted out of the entire drug database based on the input parameters for both cost (col. 39,

lines 44-53) and risk (risk of allergic reaction, col. 39, lines 55-67). The list of the drugs in FIG.
11 is a sorted list.

Claim 50: Appellant's arguments are presented at page 25 of the brief. Appellant does
not consider Examiner's citation from Mayaud, and is essentially a blanket assertion of
patentability. The rejection is maintained for the reasons cited with the discussion of claim 50
above.

Claim 60: Appellant's arguments are presented on pages 12-16 of the brief, with
additional arguments at page 25. Claim 60 was rejected under 35 USC 112. first paragraph as
containing new matter. Specifically, claim 60 recites "likelihood of adoption" and the office
action indicated that such feature was not suggested in the original specification. The rejection is
sustained for same reasons as those presented for claim 67 herein, specifically, that none of the
quotations cited on pages 12-16 of the appeal brief use the phrase of "likelihood of adoption" nor
is it anywhere suggested to the person of ordinary skill in the art at the time of invention. At best,
the quotations only suggest the construction of a proposal, not an analysis of the likelihood that
the proposal will be adopted by the user.

Claim 62: Appellant's arguments are presented at page 26 of the brief. Appellant's
arguments do not consider or discuss the quotation from col. 19, line 30 of Mayaud made in
support of the rejection. Appellant's argument is a blanket assertion that the feature is not taught,
without considering the actual quotation provided.

Claim 64: Appellant's discussion appears at page 26 of the brief. Claim 64 was grouped
together with claim 59 (page 7 of the brief), but since separate arguments are presented, claim 64
on page 26 of the brief, this claim will be individually considered. The actual arguments

presented for this claim appear to be incomplete, and seem to be chopped off in mid-sentence. The Examiner will not presume appellant's intended conclusions here, and can only note that the discussion appears to be missing words. The portion of the discussion which is actually presented admits the teaching of a client and server in Mayaud.

Claims 70, 71, 72 and 73: Appellant's discussion appears at page 26 of the brief. Claims 70, 71, 72 and 73 were rejected under 35 USC 112, first paragraph, for their dependency on independent claim 67 rejected under the same section. No prior art is applied to these claims, so the discussion pertaining to prior art is moot.

Claim 74: Appellant's arguments appear at the last page of the brief. Appellant's arguments are that Mayaud does not disclose a joint optimization. Claim 74 is not addressed to the joint optimization feature, so appellant's arguments are moot. Claim 74 calls for an economic interest distinct from the user. This is taught at col. 39, line 50 of Mayaud, where reference is made to a third party benefit management company. Appellant makes no attempt to address or discuss this citation from Mayaud.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sam Rimell
Primary Examiner
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Conferees: An appeal conference was held February 1, 2006 with Safet Metjahic, SPE,

Hosain Alam, SPE and Primary Examiner Sam Rimell. Agreement reached to proceed to appeal.

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